REMARKS

Status of Application

Claims 1-12 constitute all currently pending claims in the application.   Claims 1-12 are amended.

Claim Objections

The Examiner objects to claims 1 and 7 due to certain informalities. Claims 1 and 7 are hereby amended to address the informalities objected to by the Examiner. Applicant, therefore, respectfully requests that the Examiner withdraw the objection.

Claim Rejections Under 35 U.S.C. § 103

Claims 1–12 stand rejected under 35 U.S.C § 103(a) as allegedly being unpatentable over European Patent Application No. EP 1089506 A2 to Cao ("Cao"). Applicant traverses this rejection for at least the following reasons.

Claim 1

Amended claim 1 recites "a first network, not using an IP level protocol." Although the Examiner asserts that the ATM/IP network 1208 of Cao corresponds to the first network of claim 1, the ATM/IP network 1208 clearly employs the Internet Protocol (IP), and thus cannot correspond to the claimed first network.

Amended claim 1 further requires that the "first network" be connected to "border routers" which are "managed by a first network management system." Although Cao appears to disclose a network management system 1202, the Examiner concedes that "Cao fails to explicitly disclose a second network management system managing said designated second network." (Office Action at 4.) In this instance, the Examiner associated the SONET/SDH network 1216 with the "second network" of original claim 1, and therefore concedes that Cao fails to disclose a

network management system managing the SONET/SDH network 1216 of Cao. Moreover, Cao

discloses no element which corresponds to the "control means" of claim 1. Thus, even if the

Examiner were to associate the SONET/SDH network 1216 with the "first network" of claim 1,

this network still lacks a "network management system" and a "control means" as required by

claim 1.

The Examiner apparently attempts to compensate for Cao's lack of these elements by

taking official notice of, or arguing the inherency of, a network management system and a

control means for the SONET/SDH network 1216.

It has long been accepted that, for a claimed limitation to be inherent in a teaching, it

must be shown that "the allegedly inherent characteristic <u>necessarily</u> flows from the teachings of

the applied prior art." E.g., <u>Ex parte Levy</u>, 17 USPQ2d 1461, 1464 (U.S. PTO Bd. of Pat. App.

& Interf. 1990) (emphasis in original). As noted in MPEP § 2112[IV] (8th ed. Rev. 5, Aug.

2006), "[i]n relying upon the theory of inherency, the examiner must provide a basis in fact

and/or technical reasoning to reasonably support the determination that the allegedly inherent

characteristic necessarily flows from the teachings of the applied art" (emphasis and citations

omitted). The Examiner has not provided any such basis.

In this case, it is clear that neither a network management system, nor a control means, as

recited in claim 1, are necessary requirements of the SONET/SDH network 1216 of Cao.

Accordingly, we would respectfully request that the Examiner provide the facts and technical

reasoning to support any such assertions of inherency.

Moreover, if the Examiner intends to rely upon official notice, the Examiner is

respectfully requested to provide references in support of the argument, as the MPEP clearly

states that "[i]t would not be appropriate for the examiner to take official notice of facts without

citing a prior art reference where the facts asserted to be well known are not capable of instant

and unquestionable demonstration as being well-known." MPEP § 2144.03[A].

Thus, Cao fails to teach or suggest each and every element of amended claim 1, and

therefore, fails to render claim 1 unpatentable. Accordingly, Applicant respectfully requests that

the Examiner withdraw the rejection of amended independent claim 1 and its dependent claims 2-

12.

Claim 2

Claim 2 requires that "said service criterion is selected from a group comprising at least

quality of service, ability to protect/restore a link, and security." The Examiner cites col. 23,

lines 35-37 of Cao as allegedly teaching the elements of claim 2. Although this portion of Cao

appears to discuss a "bandwidth requirement" for supporting "QoS," this portion of Cao fails to

teach or suggest either the "ability to protect/restore a link" or "security," as recited in claim 2.

Thus, for at least these additional reasons, Cao fails to teach or suggest each and every element

of claim 2, and therefore, fails to render claim 2 unpatentable. Accordingly, Applicant

respectfully requests that the Examiner withdraw this rejection.

Claim 5

Claim 5 requires that "said modes are selected from a group comprising at least VPN,

optical VPN, and IPSec." The Examiner cites col. 22, lines 4-16 of Cao as allegedly teaching the

elements of claim 5. This portion of Cao appears to discuss the contents of the "physical path

provisioning information," which includes the bandwidth required, along with various

provisioning information; however, the cited portion of Cao fails to teach or suggest any of a

VPN, optical VPN, and IPSec, as required by claim 5. Thus, for at least these additional reasons,

Cao fails to teach or suggest each and every element of claim 5, and therefore, fails to render

claim 5 unpatentable. Accordingly, Applicant respectfully requests that the Examiner withdraw

this rejection.

Claim 6

Claim 6 requires that "some of said data defines restoration links and associated

resources." The Examiner cites col. 23, lines 44-58 of Cao as allegedly teaching the elements of

claim 6. This portion of Cao appears to discuss "the process of initializing, establishing a CAP

path and dynamically allocating bandwidth;" however, the cited portion of Cao fails to teach or

suggest anything regarding "restoration links," as required by claim 6. Moreover, the cited

portion of Cao refers to Fig. 14, which also fails to teach or suggest anything regarding

"restoration links." Thus, for at least these additional reasons, Cao fails to teach or suggest each

and every element of claim 6, and therefore, fails to render claim 6 unpatentable. Accordingly,

Applicant respectfully requests that the Examiner withdraw this rejection.

Claim 7

Claim 7 requires "memory, in which said control means stores received data in the form

of a connectivity matrix between border routers of the first network." The Examiner cites col.

21, lines 52-57, and col. 22, lines 1-16 of Cao as allegedly teaching the elements of claim 7.

This portion of Cao appears to discuss the contents of the "physical path provisioning

information" sent to the "ATM/IP side of CAP1," including the bandwidth required, and various

provisioning information; however, the cited portion of Cao fails to teach or suggest that data

received by the ATM/IP side of CAP1 is stored "in the form of a connectivity matrix between

border routers," as required by claim 5. Thus, for at least these additional reasons, Cao fails to

teach or suggest each and every element of claim 7, and therefore, fails to render claim 7

unpatentable. Accordingly, Applicant respectfully requests that the Examiner withdraw this

rejection.

Claim 8

Claim 8 recites a "a third network connected to the first network and of a different type,

and from which said call transfer request comes." The Examiner cites col. 21, lines 28-47 of Cao

as allegedly teaching the elements of claim 8.

This portion of Cao describes Fig. 12, which depicts the three networks 1208, 1216, and

1210. As discussed above, the Examiner appears to associate the ATM/IP network 1208 with

the "first network," and the SONET/SDH network 1216 with the "second network" of claim 1,

from which claim 8 depends. Claim 8, however, requires that the "call transfer request" comes

from "a third network connected to the first network." In Fig. 12 of Cao, the ATM/IP network

1208, which the Examiner associates with the "first network," is connected only to the network

1216, not the network 1210. Thus, according to the Examiner's interpretation, there is no "first

network" connected to "a third network" in Cao, as is required by claim 8. Thus, for at least

these additional reasons, Cao fails to teach or suggest each and every element of claim 8, and

therefore, fails to render claim 8 unpatentable. Accordingly, Applicant respectfully requests that

the Examiner withdraw this rejection.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed

to be in order, and such actions are hereby solicited. If any points remain in issue which the

Examiner feels may be best resolved through a personal or telephone interview, the Examiner is

kindly requested to contact the undersigned at the telephone number listed below.

This Application is being filed via the USPTO Electronic Filing System (EFS).

Applicants herewith petition the Director of the USPTO to extend the time for reply to the

above-identified Office Action for an appropriate length of time if necessary. Any fee due under

37 U.S.C. § 1.17(a) is being paid via the USPTO Electronic Filing System (EFS). The USPTO is

also directed and authorized to charge all required fees, except for the Issue Fee and the

Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said

Deposit Account.

Respectfully submitted,

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